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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,685	10/26/2000	Stijn Van Even	06698-081001	4576
26171	7590	03/22/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			STORM, DONALD L	
			ART UNIT	PAPER NUMBER
			2654	8
DATE MAILED: 03/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/696,685	EVEN ET AL.	
	Examiner Donald L. Storm	Art Unit 2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on October 26, 2000 through March 29, 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4,9-14,16 and 21-36 is/are rejected.
- 7) Claim(s) 3,5-8,15 and 17-20 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 October 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4 & 6.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 1.84(g) because lines, annotations, captions, or numbers of Figures 4B, 9, 10, 12, and 13B extend into the margin of the sheet too far to be seen clearly. Holes punched into the papers to permanently attach them to the Office file are within the drawings of the Figures. In the case of Fig. 4B and 12, some part of the drawings seems to be obliterated by punched holes. Each sheet should include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5 /8 inch), and a bottom margin of at least 1.0 cm. (3 /8 inch).

Corrected drawings (or drawings with proposed corrections highlighted, preferably in red ink) are required in response to this Office action. Corrections may no longer be held in abeyance and ANY REQUEST TO HOLD CORRECTIONS TO THE DRAWINGS IN ABEYANCE WILL NOT BE CONSIDERED A *BONA FIDE ATTEMPT TO PROVIDE A COMPLETE REPLY.*

See 37 C.F.R. § 1.121(d) and § 1.85(a), published September 8 and September 20, 2000.

### *Specification*

2. The specification is objected to because symbols (at least page 2, line 11, and pages 27-30) are not defined close to the location of first use. The discussion of these symbols includes pronunciation, but no definition. Appropriate correction is required. To avoid an objection for adding new matter to the specification, the Applicant should point out specific support in the disclosure as filed for any added definition.

3. The specification is objected to because citations to nonprovisional applications should be brought up to date if any of the applications have been abandoned or matured into patents, and as appropriate, the application serial numbers or patent numbers should be included. See MPEP 608.01 SPECIFICATION. Correction should be made throughout the disclosure, for example:

At page 24, lines 2-3, should probably include the phrase --, now US Patent 6,212,498,--.

### *Claim Informalities*

4. Claims 3, 5-8, 15, and 17-20 are objected to as being (directly or indirectly) dependent upon a rejected base claim. See MPEP § 608.01(n)V. The claim(s) would be allowable over the prior art of record if rewritten to include all of the limitations of the base claim and any intervening claims. If any objections or rejections under 35 U.S.C. 112 appear in this Office action, the claim(s) should also be rewritten to overcome them.

5. The Examiner notes, without objection, the possibility of informalities in the claims. The Applicant may wish to consider changes during normal review and revision of the disclosure.

In claim 13, line 10, if the singular noun "word" is intended to be the subject of the plural verb "correspond", it does not agree in number.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 14, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 is indefinite because the scope of a claim cannot be determined when the symbols making up the claim limitations are not defined with precision and definiteness. The symbols should be defined in the disclosure. They should also be defined in the claims at least the first time used, if a concise and accurate definition is available. No new matter may be introduced into the disclosure as filed.

9. Claim 14 is indefinite in the same way as claim 2 because the limitations are recited using obviously similar phrases.

10. Claim 26 is indefinite in the same way as claim 2 because the limitations are recited using obviously similar phrases.

***Claim Rejections - 35 USC § 101***

11. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Claim 25 is directed to a program of instructions. A list of instructions comprises only functional descriptive material. The description of instructions is not a physical article, nor is it a statutory process, as it is not acts being performed. Instructions that are not encoded on a computer-readable medium do not define both functional and structural interrelationships between the instructions and the medium, which permit the instructions' functionality to be realized. For example, encoding the instructions on computer-readable media defines structural interrelationships that permit the instructions' functionality to be realized. Functional descriptive material that is not claimed as embodied in computer-readable media is descriptive material *per se* and is not statutory because it is neither a useful process, machine, manufacture, nor composition. Functional descriptive material on computer-readable media carries out an algorithm that electrically changes a general purpose computer into a special purpose machine by activating electrical paths and deactivating other paths.

However, claim 25 is not limited to a physical medium. The alternate data carrier of claim 25 may be a further arrangement of data, namely, a propagated carrier signal; however, it appears to be functional data, inasmuch as the data of the carrier signal carries other data. Functional data alone is not statutory because it is neither a useful process, machine, manufacture, nor composition of matter. The claimed embodiment options a carrier signal, instead of a computer-readable medium. Being only a structure of data, without physical structure, it is neither a useful process, machine, manufacture, nor composition of matter. All claim limitations have been considered, and the claimed carrier signal as an alternative embodiment carrying data has been found nonstatutory as a mere arrangement of data. The claim does not recite any structural medium, and it does not recite any data structurally and functionally interrelated to a statutory class of subject matter.

14. The further limitations of the dependent claims continue to describe the arrangement of data, and do not provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Wright**

16. Claims 1, 4, 9-13, 16, 21-25, and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. [US Patent 6,601,027].

17. Regarding claim 1, Wright [at title] describes a speech recognition embodiment recognizable as a whole to one versed in the art by explicitly describing the content and functionality of the recited limitations as the following terminology:

performing speech recognition on an utterance to produce a recognition result for the utterance [at column 5, lines 26-43, as recognizer processes an utterance to identify hypotheses about text corresponding to the utterance];

the recognition result including a command [at column 22, lines 1-5, as Select];

the recognition result including a word [at column 22, lines 1-15, as <word>::=PRW];

the recognition result including a phrase [at column 22, lines 1-7, as Through <words> ordered];

determining if the word closely corresponds to a portion of the phrase [at column 22, lines 24-38, as implementing (ordered) to indicate words in the first instance of <words> appearing before words in the second instance of <words>];

producing a speech recognition result if the word closely corresponds to a portion of the phrase [at column 22, lines 1-7, as Through <words> ordered];

determining if the word closely corresponds to a portion of the phrase [at column 22, lines 24-38, as permitting hypotheses of words in the first instance of <words> appearing before words in the second instance of <words>].

18. Regarding claim 4, Wright also describes:

extracting the word and the phrase from the recognition result [at column 1, lines 42-52, as produce a single sequence of words or phrases for an utterance].

19. Regarding claim 9, Wright also describes:

producing no recognition result if the word does not correspond to the phrase [at column 22, lines 30-37, as throwing out any hypotheses that include out-of-order results].

20. Regarding claim 10, Wright also describes:

determining if previously recognized text has been selected [at column 23, lines 52-57, as procedure to replace previously recognized text if a portion of an utterance has been selected].

21. Regarding claim 11, Wright also describes:

replace selected text with the recognition result if text has been selected [at column 23, lines 52-57, as replace selected words with text produced by a correction procedure if a portion of an utterance has been selected].

22. Regarding claim 12, Wright also describes:

insert the recognition results into the text [at column 1, lines 65-66, as insert the best-scoring recognition result in the text];

insert at a predetermined location if text has not been selected [at column 24, lines 33-44, as move to the beginning or end of a previous utterance to speak a word when the user has not previously selected text].

23. Claim 13 sets forth limitations similar to limitations set forth in claim 1. Wright describes the limitations as indicated there. Wright also describes additional limitations as follows:

input device for receiving user input [at column 4, lines 15-18, as microphone and sound card];

output device for presenting information to the user [at Figs. 13A-13N and column 4, lines 16, as display];

processor with communication links to transmitting information to and from the output and input devices [at column 4, lines 16-33, as processor, I/O unit, sound card, and operating system to receive and convey speech];

memory storing software [at column 4, lines 18-21, as memory storing programs software];

the software performed by the processor for performing (the functions) [at column 4, lines 51-56, as the software indicates operations to achieve results by causing the processor to operate in the specified manner].

24. Claims 16, 21, 22, 23, and 24 set forth additional limitations similar to limitations set forth in claim 4, 9, 10, 11, and 12, respectively. Wright describes the additional limitations as indicated there.

25. Claim 25 sets forth limitations similar to limitations set forth in claim 1. Wright describes the limitations as indicated there. Wright also describes additional limitations as follows:

computer software in computer readable medium (or other) memory storing [at column 4, lines 18-21, as memory storing programs software];  
the software causing a computer to perform (the operations) [at column 4, lines 51-56, as the software indicates operations to achieve results by causing the processor to operate in the specified manner].

26. Claims 28, 33, 34, 35, and 36 set forth additional limitations similar to limitations set forth in claim 4, 9, 10, 11, and 12, respectively. Wright describes the additional limitations as indicated there.

***Conclusion***

27. The following references here made of record are considered pertinent to applicant's disclosure:

Pallakoff et al. [US Patent 5,689,617] describes recognition of a command, a word, and an unrelated phrase from speech.

Geilhufe et al. [US Patent Application Publication 2002/0193989] describes recognition of a command, a word, and a related phrase from speech.

28. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**or faxed to:**

(703) 872-9306, (for formal communications intended for entry)

**Or:**

(703) 872-9306, (for informal or draft communications, and please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA (Sixth Floor, Receptionist)

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Storm, of Art Unit 2654, whose telephone number is (703) 305-3941. The examiner can normally be reached on weekdays between 8:00 AM and 4:30 PM Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 17, 2004

  
Donald L. Storm  
Patent Examiner  
Art Unit 2654